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HP Docket No. 10011462-1

**REMARKS**

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. Reconsideration of the application in light of the following remarks is respectfully requested.

**Rejections****Rejection Under 35 USC §102**

Claim 30 has been rejected under 35 USC §102(e), as being anticipated by U.S. patent application publication 2002/0163665 to Iwata et al. ("Iwata"). Applicants respectfully traverse the rejection and request reconsideration based on features in the claim which are neither disclosed nor suggested in the cited reference.

As to a rejection under §102, "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CAFC) 221 U.S.P.Q. 385. The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The rejection of independent claim 30 is respectfully traversed at least because the single

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cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 30 recites:

“30. (Previously presented) A method of determining information regarding at least one printer available to receive a print job from a client computer, comprising:

calling a general printer driver directly from an application executed by the client computer;

transmitting a query from the client computer to a server via a network for an identification of the at least one available printer;

receiving an identification of the at least one available printer from the server;

downloading a file from the server used to convert print data into a format specific to a selected one of the at least one available printer; and

wherein the general printer driver is accessible as a destination printer in a print menu, and wherein the application is configured to launch a printing agent to initiate the transmitting when the general printer driver is selected as the destination printer.” (emphasis added)

Applicants believe that this rejection is inadequate to establish a prima facie case of anticipation because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claim and in as complete detail as in the claim. More particularly, Applicants believe that the Iwata reference does not disclose that the application is configured to launch a printing agent to initiate the transmitting of a query from the client computer to a server for identification of an available printer when the general printer driver is selected as the destination printer, as required by claim 30.

The Office states that “Fig 5, item IC4 is disclose[d] as the virtual printer driver in P[0153]” (Final Office Action, p.3). Applicants respectfully believe that the icon IC4 is not the virtual printer driver 110, but rather is an iconic control for accessing the virtual printer driver 110.

The Office further states:

“see in P[0234] that the Distributed printing properties is provided as an user interface, which is part of an appropriate application program. Thus, it can still be reasonably interpreted that the application program calls the printing agent” (Final Office Action, p.2; emphasis added).

First, Applicants respectfully disagree that the Distributed Printing Properties window is generated by or “part of” the application program 100. It is noted that the Distributed Printing

Properties window (e.g. WN2 of Fig. 11 or WN 12 of Fig. 21) is a completely different user interface from the Distributed Printing icon IC4 of the Printers window WN1 of Fig. 5:

"The operator double clicks the icon IC4 'Distributed Printing' corresponding to the virtual printer driver 110 on the 'Printer' window WN1 to open a window of the virtual printer driver 110 and clicks 'Printer' and 'Properties' in the window. This series of operations opens a dialog box 'Distributed Printing Properties' for setting various pieces of information with regard to the virtual printer" (para. [0153]; emphasis added).

The Iwata reference discloses that the Distributed Printing Properties window is the user interface 116 of the virtual printer driver 110, not of the application program 100 (Fig. 3):

"[0154] The operator double clicks the icon IC4 'Distributed Printing' corresponding to the virtual printer driver 110 on the 'Printer' window WN1 to open a window of the virtual printer driver 110 and clicks 'Printer' and 'Properties' in the window. This series of operations opens a dialog box 'Distributed Printing Properties' for setting various pieces of information with regard to the virtual printer. The operator can input the settings of the various pieces of information in the dialog box 'Distributed Printing Properties' through the operations of the mouse 20 and the keyboard 18. This dialog box 'Distributed Printing Properties' corresponds to the user interface 116 mentioned previously." (para. [0154]; emphasis added)

Furthermore, the Iwata reference teaches that the user is interacting with the virtual printer driver 110 at that point, not with the application program 100:

"[0260] The CPU 30 executes a 'Print' command provided in the application program and thereby outputs a print command for distributed printing (step S920). FIG. 27 illustrates a 'Print' dialog box WN16 open on the CRT display 12 in response to execution of the 'Print' command on the application program 100. ... The print command for distributed printing is output from the application program 100 via the operating system to the virtual printer driver 110 in response to a click of an 'OK' button id152 with the mouse 20, while a series of letters 'Distributed Printing', which corresponds to the 'Distributed Printing' icon IC4 discussed previously with FIG. 5, is selectively input in the 'Printer Name' data input box id151. A click of a 'Properties' button id153 in the 'Print' dialog box WN16 shifts the processing to a distribution information setting routine executed in the virtual printer driver 110. The process opens the 'Distributed Printing Properties' dialog box WN12 on the CRT display 12 and reads input data from the keyboard 18 and the mouse 20, so as to set various pieces of information regarding the distributed printing." (para. [0260]; emphasis added)

Thus, any actions regarding distributed printing performed as a result of the user interacting with the Distributed Printing Properties window are performed by the virtual printer

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driver 110, not the application program 100.

Second, there is no teaching that any operations associated with the Distributed Printing Properties window involve launching a printing agent to initiate the transmitting of a query from the client computer to a server for identification of an available printer. To begin with, it is not specified by the Office, nor evident to Applicants, which element of the Iwata reference the Office believes corresponds to the printing agent recited in claim 30. Claim 30 recites an application (i.e. application program 100), and a general printer driver (i.e. virtual printer driver 110). The Office states that the distributed printing utility 120 of the Iwata reference "convert[s] data to a specific format for the printer" (Final Office Action, p.3), and thus it corresponds to the downloaded server file recited in claim 30. However, the printing agent is a different element of claim 30 from the application, the general printer driver, and the downloaded server file. Thus to anticipate claim 30, the Iwata reference must disclose an element different from the application program 100, virtual printer driver 110, and distributed printing utility 120 that provides the functionality of initiating the transmission of a query from the client computer to a server via a network for an identification of the at least one available printer. The Office has not done so, and Applicants believe that the Iwata reference discloses no such element.

37 CFR §1.104(c)(2) requires that the features in the references that allegedly correspond to the limitations of the claims be pointed out with specificity. This section states:

"[T]he examiner must cite the best references at his or her command. When a reference is complex or shows or describes other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

Third, with regard to the limitation of the transmitting step, the Office cites Fig. 5 of the Iwata reference. Fig. 5 illustrates a Printer window WN1:

"The user (operator) operates the computer 10 in the following sequence to open a dialog box for setting various pieces of information required for printing on the screen of the CRT display 12. The sequence of operations 'Start' - 'Settings' - 'Printer' opens a 'Printer' window. FIG. 5 shows this 'Printer' window. In the case where the virtual printer driver 110 is installed in the computer 10, an icon IC4 that corresponds to the virtual printer driver 110 and is expressed

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as, for example, 'Distributed Printing' is displayed in the illustrated 'Printer' window WN1" (para. [0153]).

The Office states that a "query is inherently made to receive information" (Final Office Action, p.3). Applicants disagree that it is inherent to transmit a query from the client computer to a server via a network for an identification of the at least one available physical printer in conjunction with the sequence of operations of Fig. 5. The available physical printers could have been preconfigured such that no such query is required or performed.

Furthermore, Fig. 5 has nothing to do with transmitting a query when the general printer driver is selected as the destination printer in a print menu of an application, as required by the calling and transmitting steps, and the wherein clauses, of claim 1. The Iwata reference discloses that Fig. 5 is displayed upon the user entering Start – Settings – Printer from the Windows interface. This is completely different from selecting a general printer driver in the print menu of an application.

As a result, Applicants believe it cannot be reasonably interpreted that the application program launches a printing agent to initiate the transmitting of a query from the client computer to a server for identification of an available printer when the general printer driver is selected as the destination printer. The novel features of the present invention are not anticipated by the Iwata reference at least in that these essential elements, arranged as required by the claim and recited in as complete detail as in the claim, are absent from the reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

#### Rejection Under 35USC §103

Claims 1-2, 6-7, 9, 13-16, 18-27, 31-36 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent application publication 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. patent 5,692,111 to Marbry et al. ("Marbry"). Applicants respectfully traverse the rejection and request reconsideration.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has

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the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

The rejection of independent claim 1, and its dependent claims 2, 6-7, and 32-34, is respectfully traversed for at least the following reasons. In this regard, claim 1 recites:

"1. (Previously presented) A method of determining information regarding at least one physical printer available to receive a print job from a client computer, comprising:  
calling a general printer driver directly from an application executed by the client computer;  
transmitting a query from the client computer to a server via a network for an identification of the at least one available physical printer;  
receiving the identification of the at least one available physical printer from the server;  
selecting a single one of the identified physical printers to receive the print job;  
after the selecting, downloading from the server a file used to convert print data into a format specific to the selected physical printer; and  
wherein the general printer driver is accessible as a destination printer in a print menu, and wherein the general printer driver is configured to launch a printing agent to initiate the transmitting when the general printer driver is selected as the destination printer." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

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With regard to the limitation of the transmitting step, the Office cites Fig. 5 of the Iwata reference. Fig. 5 illustrates a Printer window WN1:

“The user (operator) operates the computer 10 in the following sequence to open a dialog box for setting various pieces of information required for printing on the screen of the CRT display 12. The sequence of operations ‘Start’ - ‘Settings’ - ‘Printer’ opens a ‘Printer’ window. FIG. 5 shows this ‘Printer’ window. In the case where the virtual printer driver 110 is installed in the computer 10, an icon IC4 that corresponds to the virtual printer driver 110 and is expressed as, for example, ‘Distributed Printing’ is displayed in the illustrated ‘Printer’ window WN1” (para. [0153]).

The Office states that a “query is inherently made to receive information” (Final Office Action, p.4). Applicants disagree that it is inherent to transmit a query from the client computer to a server via a network for an identification of the at least one available physical printer in conjunction with the sequence of operations of Fig. 5. The available physical printers could have been preconfigured such that no such query is required or performed.

Furthermore, Fig. 5 has nothing to do with transmitting a query when the general printer driver is selected as the destination printer in a print menu of an application, as required by the calling and transmitting steps, and the wherein clauses, of claim 1. The Iwata reference discloses that Fig. 5 is displayed upon the user entering Start – Settings – Printer from the Windows interface. This is completely different from selecting a general printer driver in the print menu of an application.

The Office does not cite the Marbry reference as teaching such limitations, and Applicants believe the Marbry reference teaches no such limitations.

Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicants’ claim limitations.

In addition, the Office has not established a *prima facie* case of obviousness at least because the combination of the references would result in an inoperative device and the references teach away from combination with each other. With regard to obviousness, it has been stated that:

“If references taken in combination would produce a ‘seemingly inoperative device’, we have held that such references teach away from the combination and thus cannot serve as

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predicates for a prima facie case of obviousness” *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 101 (Fed. Cir. 2001).

Here, combining the Iwata and Marbry references would result in an inoperative device. As a result, either or both of these references teach away from combination with the other.

Claim 1 recites that a file used to convert print data into a format specific to a selected physical printer is downloaded from a server after a single selected physical printer is identified to receive the print job. With regard to the operation of the Iwata reference, the Office identifies the virtual printer driver 110 of the reference to be the general printer driver recited in claim 1 (Final Office Action, p.3). The Office further states that “Figs. 16 item S500 and P[315] discloses that the distributed printing utility does convert data to a specific format for a printer” (Final Office Action, p.4). Accordingly, the distributed printing utility 120 of the Iwata reference corresponds to the file recited in claim 1 that is downloaded from the server. However, the distributed printing utility 120 also provides performance information about printers 60, 70, 80 to module 114 of the virtual printer driver 110 (para. [0138]-[0140]). This performance information is required in order to identify which physical printer or printers among the group of available printers should receive the print job (para. [0136]-[0138]), and in order for the application program 100 to “convert the generated video data into print data adequate for the printer (the virtual printer) based on the input performance information” (para. [0142]). Since it would not be possible for the distributed printing utility 120 to provide the performance information about printers 60, 70, 80 until the distributed printing utility 120 has already been downloaded into, and is being executed by, the client computer, the Iwata reference teaches that the downloading of the distributed printing utility 120 is performed before selecting the identified physical printer(s) to receive the print job, not after the selecting as required by claim 1.

The Office cites the Marbry reference as teaching (in Fig. 3, and at col. 3, lines 44-65) the limitations of selecting a single one of the identified physical printers to receive the print job, and, after the selecting, downloading from the server a file used to convert print data into a format specific to the selected physical printer (Final Office Action, p.4-5). However, combining



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such features of the Marbry reference with the Iwata reference would result in an inoperative device, because the Iwata reference requires that the downloaded server file (distributed printing utility 120) be in place before the physical printer or printers to receive the print job are selected. If the downloaded server file were not in place before the physical printer or printers to receive the print job are selected, the Iwata system would be inoperative. Therefore, the references teach away from combination with each other.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claims 9, 15, and 23 each recite limitations similar to those of claim 1, discussed above. Therefore, for similar reasons as explained heretofore with regard to claim 1, the applied references do not teach or suggest all of Applicants' claim limitations, and the combined references produce an inoperative device and the references teach away from the combination. Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claims 9, 15, and 23, and their corresponding dependent claims 13-14, 16, 18-22, and 24-27, is improper at least for this reason and should be withdrawn.

The rejection of independent claim 31, and its dependent claim 36, is respectfully traversed for at least the following reasons. Claim 31 recites:

"31. (Previously presented) A method of determining information regarding at least one printer available to receive a print job from a client computer, comprising:

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providing a general printer driver on the client computer accessible as a destination printer in a print menu;  
selecting the general printer driver as the destination printer directly from an application executed by the client computer;  
responsive to the selecting, launching a printing agent on the client computer from the general printer driver;  
transmitting a query from the printing agent to a server via a network for an identification of the at least one available printer;  
receiving at the client computer an identification of the at least one available printer from the server in response to the query;  
selecting, via the general printer driver, a single one of the at least one available printer to print the print job; and  
after selecting the printer, downloading from the server to the client computer a file configured to convert the print job into a format specific to the selected printer; and  
printing the print job on the selected printer.” (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant’s claim limitations.

With regard to the limitations of the providing and selecting steps, the Office cites Fig. 5 of the Iwata reference (Final Office Action, p.6-7). For similar reasons as have been explained heretofore with regard to claim 1, Fig. 5 does not teach or suggest selecting a general printer driver from an application, or selecting a single available printer to print a print job, as required by claim 31.

With regard to the limitation of launching a printing agent on the client computer from the general printer driver responsive to selecting the general printer driver as the destination printer, the Office merely cites Fig. 35, the Distributed Printing Properties dialog box WN12 including a Printer card CD12 displayed thereon. The Distributed Printing Properties dialog box WN12 is generated by virtual printer driver 110 and corresponds to user interface 116 (para. [0154]). However, to whatever extent, if any, that the Office may consider the printing agent to be user interface 116, the printing agent recited in claim 31 is a separate element from the general printer driver, not part of the general printer driver as in the Iwata reference. Furthermore, the Iwata reference does not teach or suggest that the Distributed Printing Properties dialog box

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WN12 transmits a query to a server via a network for an identification of the at least one available printer, as recited in claim 31.

In addition, and also for similar reasons as discussed heretofore with regard to claim 1, the display of specific printers LP-100, LP-200, LP-300 in printers box id113 of Fig. 35 requires that the distributed printing utility 120 is already executing in order to provide the performance information about printers 60, 70, 80 included on the Distributed Printing Properties window WN12 to module 114 of the virtual printer driver 110 (para. [0138]-[0140]). The Office states that the distributed printing utility 120 corresponds to the file which converts data to a specific format for a printer (Final Office Action, p.4). However, claim 31 recites that the file which converts data to a specific format for a printer is downloaded only after the printer has been selected, which is performed by the Distributed Printing Properties dialog box WN12 of Fig. 35. As such, since Distributed Printing Properties window WN12 could not be generated without the distributed printing utility 120 already having been downloaded, the Iwata reference does not teach or suggest the sequential order of execution of the steps of claim 31.

Furthermore, claim 31 as amended recites that a single one of the identified physical printers is selected to receive the print job. Conversely, the Iwata reference is directed to distributing the print job among multiple printers. "Output of the print data to multiple printers in a distributive manner desirably shortens the total time required for printing" (para. [0002]). "The present invention is directed to a first distributed printing control apparatus, which includes: a data allocation module that divides print data, which is an object to be printed, by page and specifies information representing pages allocated to multiple printers; and a data output control module that outputs the print data in a distributive manner to the multiple printers according to the information specified by the data allocation module" (para. [0016]).

Although claim 31 was rejected under §103(a) based on both the Iwata and Marbry references, the Office does not cite the Marbry reference as teaching any of the limitations of claim 31. Applicants believe the Marbry reference does not teach the limitations discussed above and absent from the Iwata reference.

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Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicant's claim limitations.

Furthermore, for similar reasons as have been described heretofore with regard to claim 1, the Office has not established a *prima facie* case of obviousness at least because the references would produce an inoperative device if combined, and teach away from combination with each other.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

The rejection of dependent claim 35 is respectfully traversed at least based on the dependence of this claim on independent claim 30, whose reasons for allowability over the Iwata reference have been discussed heretofore and against which the Marbry reference has not been cited. Therefore, the rejection is improper at least for this reason and should be withdrawn.

Claims 3 and 17 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. patent application publication 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. patent 5,692,111 to Marbry et al. ("Marbry") and further in view of Official Notice. Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of these claims on independent claim 1 and 15 respectively, whose reasons for allowability over the Iwata and Marbry references have been discussed heretofore. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claims 4-5, 11-12, 18-19, and 24 have been rejected under 35 USC §103 (a), as being

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unpatentable over U.S. patent application publication 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. patent 5,692,111 to Marbry et al. ("Marbry") and further in view of U.S. patent 5,580,177 to Gase et al. ("Gase"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of these claims on one of independent claims 1, 9, 15, and 23, whose reasons for allowability over the Iwata and Marbry references have been discussed heretofore and against which the Gase reference has not been cited. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

#### Conclusion

Attorney for Applicant(s) has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

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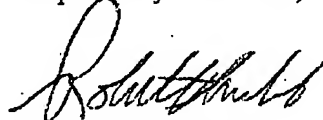
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Respectfully submitted,



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